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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,375	04/15/2004	Ariel S. Pfeffer-Slobodinsky	112701-574	6619
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BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135				
EXAMINER VU, JAKE MINH				
ART UNIT			PAPER NUMBER	
1618				

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,375

Applicant(s)

PFEFFER-SLOBODINSKY, ARIEL
S.

Examiner

Jake M. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Applicant's Restriction Requirement Response and Amendment filed on 08/14/2006, and the Information Disclosure Statements filed on 09/17/2004 and 08/14/2006. Claims 1-21 have been cancelled and new claims 32-44 have been added. Claims 22-44 are pending in the instant application.

Election/Restrictions

Applicant's election without traverse of Group II in the reply filed on 08/14/2006 is acknowledged.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 22-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending Application No. 10/444,739. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application recites a method for preserving the cutting edge of a blade (see claim 1) comprising the step of immersing the blade into a composition comprising: an ether compound, such as sodium lauryl ether (see claim 16); a hydrophobic compound, such as glycerin (see claim 17); and an alcohol, such as cetostearyl alcohol (see claim 18). The only difference between the instant claims and that copending claims is that the blade, which is a utensil is specified. It would have been obvious to one of ordinary skill in the art to select the utensil because the copending application claims the specie blade.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22, 26, 28, 29-32, 35, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by SMITH (US 5,958,394).

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Applicant's claims are directed to a method for preserving the cutting edge of a utensil by immersing the cutting edge of the utensil in a composition comprising of: an ether compound; a hydrophobic compound, such as glycerin; and an alcohol.

SMITH disclosed a method for blade edge preservation (see abstract and col. 3, line 27-28) comprised of applying a composition comprised of: an ether compound, such as a polyether (see col. 3, line 33); a hydrophobic compound, such as glycerol (see abstract), which is glycerin; and an alcohol (see col. 3, line 61). Additional disclosures include: perfume fragrance (see abstract); and a lubricant, such as 2.0% lecithin (see col. 4, line 19).

Claims 22, 28, 29-32, 35, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by NEUBAUER (US 6,039,937).

NEUBAUER disclosed a method for enhancing the useful life of the razor blade (see abstract), which would read on preserving the cutting edge of a utensil, by immersing the razor blade in a composition comprised of: a chloride compound (see col. 5, line 45); a hydrophobic compound, such as vitamin E (see col. 5, line 40); and an alcohol (see col. 5, line 49; claim 8). Additional disclosures include: a lubricant, such as mineral oil (see col. 5, line 38); and fragrance (see col. 2, line 49).

Note, although the references are silent about maintaining a chromic oxide protective film on the cutting edge and formation of iron oxide on the surface of the cutting edge, it does not appear that the claim language or limitations result in a

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manipulative difference in the method steps when compared to the prior art disclosure. See *Bristol-Myers Squibb Company v. Ben Venue Laboratories*, 58 USPQ2d 1508 (CAFC 2001). "It is a general rule that merely discovering and claiming a new benefit of an old process cannot render the process again patentable." *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Granting a patent on the discovery of an unknown but inherent function would remove from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art. *In re Baxter Travenol Labs*, 21 USPQ2d 1281 (Fed. Cir. 1991). See M.P.E.P. 2145. On this record, it is reasonable to conclude that the same blade is immersed in the same composition in both the instant claims and the prior art reference. The fact that Applicant may have discovered yet another beneficial effect from the method set forth in the prior art does not mean that they are entitled to receive a patent on that method.

Thus, the reference teaches, either expressly or impliedly, each and every limitation of the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 22-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over SMITH (cited supra) or NEUBAUER (cited supra) in view of ENDRIIS et al (US 6,660,768) and DEWAR et al (US 4,157,977).

As discussed above, SMITH disclosed a method for blade edge preservation (see abstract and col. 3, line 27-28) comprised of applying a composition comprised of: an ether compound, such as a polyether (see col. 3, line 33); a hydrophobic compound, such as glycerol (see abstract), which is glycerin; and an alcohol, such as isopropanol (see col. 3, line 61). Additional disclosures include: perfume fragrance (see abstract); and a lubricant, such as 2.0% lecithin (see col. 4, line 19).

NEUBAUER disclosed a method for enhancing the useful life of the razor blade (see abstract), which would read on preserving the cutting edge of a utensil, by immersing the razor blade in a composition comprised of: a chloride compound (see col. 5, line 45); a hydrophobic compound, such as vitamin E (see col. 5, line 40); and an alcohol (see col. 5, line 49; claim 8). Additional disclosures include: a lubricant, such as mineral oil (see col. 5, line 38); and fragrance (see col. 2, line 49).

The references do not teach mixing and homogenizing the composition before use or specifically using stainless steel metals having memory properties or using specific ingredients, such as sodium sulphate lauryl ether, cetyltrimethyl ammonium chloride or triethanolamine.

ENDRIIS disclosed wetting agents such as glycerol, sodium lauryl sulfate ether, and cetyltrimethyl ammonium chloride (see col. 4, line 16-27).

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DEWAR disclosed alcohol solvents, such as ethanol, isopropanol, and triethanolamine (see col. 3, line 60-61).

It would have been obvious to the person of ordinary skill in the art at the time the invention was made to use stainless steel metals with memory properties with SMITH or NEUBAUER's method. The person of ordinary skill in the art would have been motivated to make those modifications and reasonably would have expected success because it is known in the art that stainless steel memory blades are used in widely used in razor blades (see Specification at [0016]).

The references do not specifically teach mixing and homogenizing the composition as claimed by Applicant. The mixing of an aqueous composition before use is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ and reasonably would expect success. It would have been customary for an artisan of ordinary skill to mix the aqueous composition before use to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of Applicant's invention.

It would have been obvious to the person of ordinary skill in the art at the time the invention was made to incorporate specific ingredients, such as sodium sulphate lauryl ether, cetyltrimethyl ammonium chloride or triethanolamine into SMITH or NEUBAUER's methods. The person of ordinary skill in the art would have been motivated to make

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those modifications and reasonably would have expected success because these are interchangeable ingredients well known in the art.

Claims 37-44 are free of the art of records, but are objected to as being dependent upon a rejected base claim.

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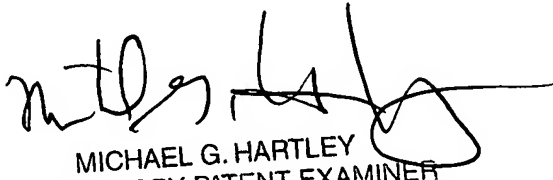
Telephonic Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jake M. Vu whose telephone number is (571) 272-8148. The examiner can normally be reached on Mon-Fri 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jake M. Vu, PharmD, JD
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MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER